

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In the Matter of Application Serial Number 75/842,202  
Published in the Official Gazette on February 4, 2003

04-07-2003

U.S. Patent & TMO/TM Mail Rcpt Dt. #01

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V SECRET CATALOGUE, INC.,  
VICTORIA'S SECRET STORES, INC.  
INTIMATE BEAUTY CORPORATION  
D/B/A VICTORIA'S SECRET BEAUTY, and  
VICTORIA'S SECRET DIRECT, LLC,

Opposition No.

Opposers,

v.

WOMEN'S SECRETS, S.A.,

Applicant.  
-----X

NOTICE OF OPPOSITION

V SECRET CATALOGUE, INC., a Delaware corporation, having its principal office and place of business at 1105 North Market Street, Wilmington, Delaware 19801, VICTORIA'S SECRET STORES, INC., a Delaware corporation, having its principal office and place of business at Four Limited Parkway, Reynoldsburg, Ohio 43068, INTIMATE BEAUTY CORPORATION D/B/A VICTORIA'S SECRET BEAUTY, a Delaware corporation, having its principal office and place of business at 888 Seventh Avenue, New York, New York 10106, and VICTORIA'S SECRET DIRECT, LLC, a Delaware limited liability company, having its principal office and place of business at 3425 Morse Crossing, Columbus, Ohio 43219 (herein referred to collectively as "Victoria's Secret" or "opposers"), believe they will be damaged by registration of the designation

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WOMEN'S SECRET in Application Serial No. 75/842,202, filed November 5, 1999, published at page TM 10-11 of the Official Gazette of February 4, 2003 (Vol. 1267, No. 1), for the goods set forth therein, in International Classes 3 (U.S. Classes 1, 4, 6, 50, 51 and 52) and 25 (U.S. Classes 22 and 39).

As grounds of opposition, opposers aver that:

1. WOMEN'S SECRETS, S.A. (herein "applicant"), a foreign corporation, having its principal office and place of business at Avda. del Llano Castellano 51, 28034 Madrid, Spain, is not now and never was entitled to register as a trademark the designation WOMEN'S SECRET for which it seeks registration in its Application Serial No. 75/842,202, filed on November 5, 1999, published at pages TM 10-11 of the Official Gazette of February 4, 2003 (Vol. 1267, No. 1), for the goods set forth therein, namely, facial lotions; cleansing milks for cleaning the skin; eye makeup remover in gel form; pre-moistened cosmetic tissues for removing makeup; nourishing skin creams; moisturizing anti-age skin creams; ampoules containing moisturizers; skin moisturizing lotions; non-medicated lip protecting preparations; preparations for body care, namely, non-medicated skin gels for cosmetic and cleaning purposes and skin moisturizing milk; cosmetic preparations for slimming purposes, namely, non-medicated skin creams and skin lotions for cellulite reduction; non-medicated skin creams and skin lotions to treat stretch marks; non-medicated skin creams and skin lotions to firm the skin; hand creams; preparations for sun tanning, namely, sun block and sun creams; fragrances, namely, eau de toilette,

perfume and scented body spray in International Class 3 (U.S. Classes 1, 4, 6, 50, 51 and 52) and brassieres; body suits; teddies; corsets; bustiers; combinations; tops; undershirts; panties; tangas; girdles; culottes; pajamas; camisoles; dressing gowns; bathrobes; jackets; shirts; sweat shirts; trousers; leggings; shorts; overalls, skirts; slippers; caps; bonnets; stockings; mini-stockings, namely, footlets; socks; bikinis; bathing suits; pareu; and swimming trunks in International Class 25 (U.S. Classes 22 and 39).

2. Applicant is not entitled to use or register as a trademark the designation WOMEN'S SECRET for which it seeks registration in its Application Serial No. 75/842,202, either on November 5, 1999, the date of filing of said application, or on February 4, 2003, the date of publication thereof in the Official Gazette.

3. Opposer, V Secret Catalogue, Inc. is the owner and opposers, Victoria's Secret Stores, Inc., Intimate Beauty Corporation d/b/a Victoria's Secret Beauty, and Victoria's Secret Direct, LLC, are the exclusive users of the trademark and service mark VICTORIA'S SECRET (the "VICTORIA'S SECRET Mark"), which is registered in the United States Patent and Trademark Office under Registration Nos. 1,146,199 and 1,224,782. Copies of said registrations are annexed hereto and incorporated herein by reference as opposers' Exhibits A and B. Said registrations are outstanding, validly subsisting and uncanceled.

4. Since long prior to applicant's selection and adoption of the designation WOMEN'S SECRET, opposers have been continuously and now are engaged in the manufacture, advertising, offering for sale and sale of a wide range of goods and services, including, but not limited to women's and men's clothing, accessories, and personal care products, as well as retail clothing store and mail order services in interstate commerce throughout the United States.

5. Since long prior to applicant's selection and adoption of the designation WOMEN'S SECRET, opposers have been continuously and now are advertising, offering for sale and selling in interstate commerce throughout the United States the aforesaid goods and services under the VICTORIA'S SECRET Mark.

6. Upon the introduction of the aforesaid goods and services of opposers so marked upon the market and continuously thereafter, opposers became and are now widely known and recognized by the VICTORIA'S SECRET Mark, which mark is closely and universally associated with opposers as a means by which opposers and their said goods and services have become known to the public and their source or origin identified.

7. As a result of opposers' extensive advertising and promotion of their goods and services under the VICTORIA'S SECRET Mark, the large volume of sales of goods bearing the VICTORIA'S SECRET Mark, and the extensive media coverage that opposers and their goods and services have received, the VICTORIA'S SECRET Mark has become and now is a famous trademark in the United States, as well as internationally.

8. Applicant's adoption and intent to use the designation WOMEN'S SECRET is without license or permission of opposers.

Count I - Likelihood of Confusion

9. Opposers repeat and reaver the averments set forth in paragraphs 1 through 8 inclusive of this notice of opposition as if more fully set forth herein again.

10. Applicant's goods are closely related to opposers' goods and services, will be sold to the same class of purchasers, and will be available for sale through the same or similar channels of trade.

11. The designation applicant seeks to register, namely, WOMEN'S SECRET, so resembles opposers' VICTORIA'S SECRET Mark, as to be likely, when applied to the goods of applicant, to cause confusion or mistake or to deceive persons by creating the erroneous impression that applicant's goods originate with or come from the same source as opposers' goods and/or services, or are endorsed by, or are sponsored by, or are connected in some way with opposers, and the registration thereof would be injurious to opposers.

Count II - Dilution

12. Opposers repeat and reaver the averments set forth in paragraphs 1 through 8 inclusive of this notice of opposition as if more fully set forth herein again.

13. Applicant's proposed use and registration of the designation WOMEN'S SECRET is likely to, and will dilute, blur and erode the distinctiveness of opposers' famous VICTORIA'S SECRET

Mark, and/or damage the goodwill associated with the VICTORIA'S SECRET Mark.

WHEREFORE, opposers pray that Application Serial No. 75/842,202 be rejected and that registration of the designation WOMEN'S SECRET as a trademark to applicant be refused and denied, and/or that opposers have such other and further relief as the Board may deem just and proper.

Dated: New York, New York  
April 3, 2003

COLUCCI & UMANS

I hereby certify that this correspondence is being deposited with the United States Postal Service as First Class Mail in an envelope addressed to: Assistant Commissioner for Trademarks, 2800 Crystal Drive, Arlington, VA 22202-3513

By

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Kathleen M. McLean  
Signature  
4/3/03  
Date of Signature

RECYCLED



Int. Cl.: 25

Prior U.S. Cl.: 39

**United States Patent and Trademark Office**

**Reg. No. 1,146,199**

**Registered Jan. 20, 1981**

**TRADEMARK**  
**Principal Register**

**VICTORIA'S SECRET**

Victoria's Secret (partnership)  
1560 Waller St.  
San Francisco, Calif. 94117

For: WOMEN'S LINGERIE, in CLASS 25 (U.S.  
Cl. 39).

First use Jun. 12, 1977; in commerce Jun. 12, 1977.

Ser. No. 159,253, filed Feb. 21, 1978.

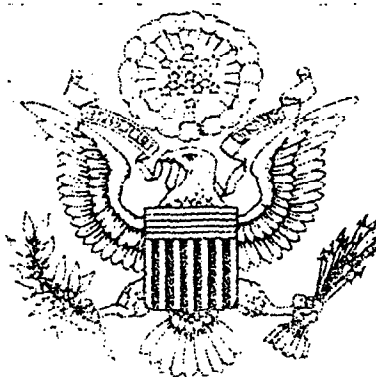
J. H. WEBB, Primary Examiner



RECYCLED



# The United States of America



## CERTIFICATE OF REGISTRATION

This is to certify that the records of the Patent and Trademark Office show that an application was filed in said Office for registration of the Mark shown herein, a copy of said Mark and pertinent data from the Application being annexed hereto and made a part hereof,

And there having been due compliance with the requirements of the law and with the regulations prescribed by the Commissioner of Patents and Trademarks,

Upon examination, it appeared that the applicant was entitled to have said Mark registered under the Trademark Act of 1946, as amended, and the said Mark has been duly registered this day in the Patent and Trademark Office on the

## PRINCIPAL REGISTER

to the registrant named herein.

This registration shall remain in force for TEN years unless sooner terminated as provided by law.



In Testimony whereof I have hereunto set my hand and caused the seal of the Patent and Trademark Office to be affixed this first day of August 1995.

*Bence Lehman*

Commissioner of Patents and Trademarks

Int. Cls.: 3, 4, 9, 16, 20, 21, 22, 24, 25, 28 and 42

Prior U.S. Cls.: 1, 2, 4, 5, 6, 13, 15, 22, 23, 29, 30,  
32, 33, 36, 37, 38, 39, 40, 42, 50, 51, 52, 100 and 101    Reg. No. 1,908,042  
**United States Patent and Trademark Office**    Registered Aug. 1, 1995

**TRADEMARK  
SERVICE MARK  
PRINCIPAL REGISTER**

**VICTORIA'S SECRET**

V. SECRET CATALOGUE, INC. (DELAWARE  
CORPORATION)  
1105 NORTH MARKET STREET  
WILMINGTON, DE 19801

FOR: TOILET SOAPS, WASHING COM-  
POUNDS FOR USE WITH LINGERIE AND  
FINE WASHABLES, HAIR SHAMPOOS,  
SCENTED DRAWER SACHETS; PERSONAL  
FRAGRANCES, NAMELY COLOGNE, PER-  
FUME, TOILET WATER, AND ESSENTIAL  
OILS FOR PERSONAL USE; BATH POWDER,  
NON-MEDICATED FOOT POWDER, AND  
BODY POWDER; AND PERSONAL CARE  
PREPARATIONS, NAMELY BATH, HAND  
AND BODY LOTIONS, IN CLASS 3 (U.S. CLS. 1,  
4, 6, 50, 51 AND 52).

FIRST USE 6-12-1977; IN COMMERCE  
6-12-1977.

FOR: CANDLES, IN CLASS 4 (U.S. CL. 15).

FIRST USE 6-12-1977; IN COMMERCE  
6-12-1977.

FOR: PRERECORDED COMPACT DISCS  
AND AUDIO TAPES, BOTH FEATURING  
MUSIC, IN CLASS 9 (U.S. CL. 36).

FIRST USE 6-12-1977; IN COMMERCE  
6-12-1977.

FOR: MAIL ORDER CATALOGS FEATUR-  
ING CLOTHING, LINGERIE, AND TOILE-  
TRIES; BRIDAL GUEST BOOKS; CALENDARS,  
AND ADDRESS BOOKS, IN CLASS 16 (U.S.  
CLS. 2, 5, 22, 23, 29, 37, 38 AND 50).

FIRST USE 6-12-1977; IN COMMERCE  
6-12-1977.

FOR: PICTURE FRAMES, HAND MIRRORS  
AND PILLOWS, IN CLASS 20 (U.S. CLS. 32  
AND 50).

FIRST USE 6-12-1977; IN COMMERCE  
6-12-1977.

FOR: PERFUME ATOMIZERS SOLD EMPTY;  
PERFUME BOTTLES SOLD EMPTY; NON-  
METAL DECORATIVE BOXES; HAIR COMBS  
AND HAIR BRUSHES; DECORATIVE TRAYS  
NOT OF PRECIOUS METAL; AND FLASKS  
SOLD EMPTY, IN CLASS 21 (U.S. CLS. 2, 13, 23,  
29, 30, 33, 40 AND 50).

FIRST USE 6-12-1977; IN COMMERCE  
6-12-1977.

FOR: MESH LINGERIE BAGS FOR WASH-  
ING LINGERIE AND CLOTH BAGS FOR LIN-  
GERIE STORAGE, IN CLASS 22 (U.S. CL. 2).

FIRST USE 6-12-1977; IN COMMERCE  
6-12-1977.

FOR: WASH CLOTHS, TOWELS AND BED-  
DING, NAMELY COMFORTERS, PILLOW  
CASES, SHEETS, SHAMS, DUVETS, AND  
DUST RUFFLES, IN CLASS 24 (U.S. CL. 42).

FIRST USE 6-12-1977; IN COMMERCE  
6-12-1977.

FOR: WOMEN'S AND MEN'S OUTERWEAR,  
UNDERWEAR AND NIGHTWEAR, NAMELY  
LINGERIE, ROBES, CAFTANS, KIMONOS,  
BOXER SHORTS, PAJAMAS, SHIRTS, PANTS,  
JEANS, DRESSES, SKIRTS, SWEATERS, JUMP-  
SUITS, BODYSUITS, SWEATSHIRTS, JACKETS,  
T-SHIRTS, SCARVES, LEOTARDS, TIGHTS,  
SWIMSUITS, BEACH SHIRTS, HOSIERY, FOOT-  
WEAR, IN CLASS 25 (U.S. CLS. 22 AND 39).

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1,908,042

FIRST USE 6-12-1977; IN COMMERCE 6-12-1977.

FOR: TOY STUFFED ANIMALS, IN CLASS 28 (U.S. CL. 22).

FIRST USE 6-12-1977; IN COMMERCE 6-12-1977.

FOR: RETAIL STORE AND MAIL ORDER CATALOG SERVICES FOR LINGERIE CARE PREPARATIONS, PERSONAL CARE PREPARATIONS, PERFUMES, CANDLES, PICTURE FRAMES, MIRRORS, COSMETIC AND PERFUME APPLICATORS, TOWELS, BEDDING,

WOMEN'S AND MEN'S LINGERIE, UNDERGARMENTS AND CLOTHING AND TOYS, IN CLASS 42 (U.S. CLS. 100 AND 101).

FIRST USE 6-12-1977; IN COMMERCE 6-12-1977.

OWNER OF U.S. REG. NOS. 1,146,199, 1,533,217 AND OTHERS.

SER. NO. 74-507,663, FILED 3-31-1994.

CATHERINE KAISER KREBS, EXAMINING ATTORNEY